REMARKS

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the following remarks.

Claims 1-8 are pending in the subject applications. Claims 1-8 stand rejected under 35 U.S.C. §103(a) over JP 07026212 A either individually, or in view of JP 11021519 A.

35 U.S.C. §103 Rejections

Claims 1-8 have been rejected under 35 U.S.C. §103(a) as being unpatentable over JP 07026212 A either individually, or in view of JP 11021519 A. In addition to the reasons set forth in section 4 of Paper No. 3, the Office further states:

> With respect to Applicant's amendment to limit the hydrogenated styrene/butadiene copolymer as the type of a random copolymer, the Examiner takes Official notice that it is well known that both block or random copolymer of styrene/butadiene are suitable as pressure and function equivalently for protective film application, and it is with in the ordinary skill in the art to substitute one for another. Note also as evidence the state of the art EP 203425 A (Derwent Abstract), which teaches that a tie layer for polyolefin layers may be a random block, diblock or triblock of styrene and butadiene copolymer. It should be noted that a random block copolymer inherently encompasses a random copolymer.

Applicants respectfully traverse this rejection.

In claim 1, Applicants claim a pressure-sensitive adhesive sheet comprising a three-layered film of a layer A, a layer B and a layer C and a pressure-sensitive adhesive layer on layer C. Layer A contains a polyethylene polymer in an amount of at least 60 % by weight based on a total weight of the layer A. Layer B contains a polypropylene polymer in an amount of at least 50 % by weight based on a total weight of the layer B. Layer C contains a hydrogenated styrene/diene hydrocarbon <u>random</u> copolymer in an amount of at least 10 % by weight based on a total weight of layer C.

JP 07026212 A, on the other hand, describes a surface protective film that includes a "layer comprising a polyolefinic resin alone, a layer of a modified block copolymer formed by modifying a block copolymer of an A-B-A type and/or a block copolymer of an A-B type (wherein A is a styrenic polymer block; and B is an olefin polymer block formed by hydrogenating a butadiene polymer block) with an acid, and a self-adhesive layer". (Abstract) The JP 07026212 A, reference does not describe or otherwise suggest random copolymers as taught by the present invention.

Applicants respectfully submit that block copolymers taught by the present invention are not equivalent to the random copolymers described by the JP 07026212 A reference. As specifically set out by the JP 07026212 A reference, acid treatment/modification of the block copolymer is required. On the other hand, the pressure-sensitive adhesive sheets taught by Applicants do not require acid treatment/modification. As specified by Applicants, Applicants' pressure-sensitive adhesive sheets "can be manufactured inexpensively with reduced manufacturing process, since no anchor coat treating procedure is required." (Page 1, lines 11-14) Further, in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958)

In view of the above, Applicants respectfully disagree with the Examiner's statement that "both block or random copolymer of styrene/butadiene are suitable as pressure and function equivalently for protective film application."

The JP 11021519 A reference is equally deficient. The JP 11021519 A reference does not describe or otherwise suggest a pressure-sensitive adhesive sheet that includes a layer that "contains a hydrogenated styrene/diene hydrocarbon random copolymer in an amount of at least 10 % by weight based on a total weight of the layer C," as required by Applicants' claim 1. Further, the Examiner has not pointed to any disclosure or suggestion of this element in the JP 11021519 A reference.

Further, the Office refers to EP 203425 A, which describes that a tie layer for polyolefin layers may be a random block, diblock or triblock of styrene and butadiene copolymer. The Office asserts that a random block copolymer inherently encompasses a random copolymer. Applicants respectfully submit that, in connection with the random block copolymer, EP 203425 A states "The random block copolymer such as Stereon 840A is made up of various unit blocks of varying length. Although referred to generally as a random block copolymer, Steron 840A may be tapered as well, that is a block of styrene followed by a block of butadiene followed by a shorter block of styrene than the first block which is followed by a shorter block of butadiene than the first block followed by a still shorter block of styrene, etc." (column 7, lines 9-18) In other words, a "random block copolymer", as described by EP 203425 A, refers to a copolymer where styrene blocks and butadiene blocks have been arranged at random. This is not consistent with Applicants' definition of random copolymers or with the definition of typical random copolymers.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

In view of the above, Applicants respectfully disagree with the Office's assertion that " Note also as evidence the state of the art EP 203425 A (Derwent Abstract), which

teaches that a tie layer for polyolefin layers may be a random block, diblock or triblock of styrene and butadiene copolymer. It should be noted that a random block copolymer inherently encompasses a random copolymer."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142.

As clearly set out above, the JP 07026212 A and JP 11021519 A references do not teach or suggest all the claim limitations. In particular, the JP 07026212 A and JP 11021519 A references fail to teach or suggest a pressure-sensitive adhesive sheet that includes a layer that "contains a hydrogenated styrene/diene hydrocarbon random copolymer in an amount of at least 10 % by weight based on a total weight of the layer C," as required by Applicants' claim 1. Further, there is no suggestion or motivation to modify the references to teach all of Applicants' claim limitations.

Accordingly, claim 1 is patentable over the JP 07026212 A and JP 11021519 A references and further in view of the EP 203425 A reference. Claims 2-8 depend from claim 1 and, likewise, are patentable over the JP 07026212 A and JP 11021519 A references and further in view of the EP 203425 A reference.

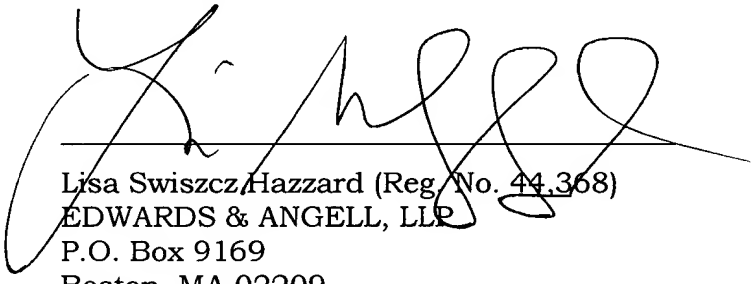
CONCLUSION

Reconsideration and allowance of claims 1-8 is respectfully requested in view of the foregoing discussion. This case is believed to be in condition for immediate allowance. Applicants respectfully requests early consideration and allowance of the subject application.

Applicants believe that no extension of time is required since this response is being filed before the expiration of the specified time period. Applicants, however, conditionally petition for an extension of time to provide for the possibility that such a petition has been inadvertently overlooked and is required. As provided below charge Deposit Account No. **04-1105** for any required fee.

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so.

Respectfully submitted,



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